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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/311,753	05/14/1999	TSUYOSHI INOUE	Q54370	1662

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SUGHRUE, MION, ZINN, MACPEAK & SEAS
2100 PENNSYLVANIA AVENUE N W
WASHINGTON, DC 20037

EXAMINER

BERNATZ, KEVIN M

ART UNIT PAPER NUMBER

1773

DATE MAILED: 02/06/2003

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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/311,753

Applicant(s)

INOUE ET AL.

Examiner

Kevin M Bernatz

Art Unit

1773

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 2 and 3 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 2 and 3 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). ____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 24. 6) ☐ Other: .

DETAILED ACTION

Response to Amendment

1. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Request for Continued Examination

2. The Request for Continued Examination (RCE) under 37 CFR 1.53 (d) filed on November 20, 2002 is acceptable and a RCE has been established. An action on the RCE follows.

Election/Restrictions

3. Applicants' shift of inventions in the RCE filed November 20, 2002 has been approved. See MPEP 819 and 819.01.

Claim Rejections - 35 USC § 103

4. Claims 2 and 3 are rejected under 35 U.S.C. 103(a) as being unpatentable over Miyahara et al. ('751 A) in view of any one of Arakawa et al. (JP 07-328528 A), Müssig (U.S. Patent No. 6,319,353 B1) or Matsui et al. (EP 768354 A2). See provided Abstract translations and Machine translations of JP '751 A and JP '528 A.

Regarding claim 2, Miyahara et al. disclose a sheet which comprises a support comprising a polymer film laminated on one or both surfaces of a non-woven fabric, and

a pressure-sensitive adhesive layer formed on one surface of said polymer film opposed to the polymer film surface adhered to the non-woven fabric, wherein said non-woven fabric has a basis weight of 5 to 100 g/m² and said polymer film comprises a thermoplastic polymer (JPO Abstract and Constitution; Figure 1; Machine Translation paragraphs 0007 – 0013 and 0019).

Miyahara et al. fail to disclose a method of protecting paint films of automobiles using the disclosed sheet.

However, Arakawa et al., Müssig and Matsui et al. all teach that it is old in the art to use plastic films with a pressure sensitive adhesive layer as a method of protecting paint films of automobiles during transport and delivery in order to protect them from debris, dirt, etc. (*Arakawa et al. – Abstract & Machine Translation Paragraphs 0001 – 0003; Müssig – col. 1, lines 1 – 40; col. 2, lines 29 – 33; col. 3, lines 35 – 40; and col. 6, line 55 bridging col. 7, line 8; Matsui et al., page 2, lines 12 – 21*).

It would therefore have been obvious to one of ordinary skill in the art at the time of the applicant's invention to modify the device of Miyahara et al. to be used as a method of protecting a paint film of an automobile from debris and dirt as taught by Arakawa et al., Müssig and Matsui et al., since it is taught that it is known in the art to use plastic films with pressure sensitive adhesive coatings as protective films for automobile paint.

Regarding claim 3, Miyahara et al. disclose a polymer film meeting applicants' claimed limitations (Machine Translation paragraphs 0013 and 0019 and Examples 2 and 3 in Table 1).

5. Claims 2 and 3 are rejected under 35 U.S.C. 103(a) as being unpatentable over Seth ('964) in view of any one of Arakawa et al. ('528 A), Müssig ('353 B1) or Matsui et al. ('354 A2). See provided Abstract translations and Machine translations of JP '751 A and JP '528 A.

Regarding claim 2, Seth discloses a sheet which comprises a support comprising a polymer film laminated on one or both surfaces of a non-woven fabric, and a pressure-sensitive adhesive layer formed on one surface of said polymer film opposed to the polymer film surface adhered to the non-woven fabric, wherein said non-woven fabric has a basis weight of 5 to 100 g/m² and said polymer film comprises a thermoplastic polymer (col. 2, lines 54 – 59; col. 4, lines 14 – 15; col. 5, lines 7 – 25; col. 6, lines 35 – 64; and Figure 3).

Seth fails to disclose a method of protecting paint films of automobiles using the disclosed sheet.

However, Arakawa et al., Müssig and Matsui et al. all teach that it is old in the art to use plastic films with a pressure sensitive adhesive layer as a method of protecting paint films of automobiles during transport and delivery in order to protect them from debris, dirt, etc. (*Arakawa et al. – Abstract & Machine Translation Paragraphs 0001 – 0003; Müssig – col. 1, lines 1 – 40; col. 2, lines 29 – 33; col. 3, lines 35 – 40; and col. 6, line 55 bridging col. 7, line 8; Matsui et al., page 2, lines 12 – 21*).

It would therefore have been obvious to one of ordinary skill in the art at the time of the applicant's invention to modify the device of Seth to be used as a method of

protecting a paint film of an automobile from debris and dirt as taught by Arakawa et al., Müssig and Matsui et al., since it is taught that it is known in the art to use plastic films with pressure sensitive adhesive coatings as protective films for automobile paint.

Regarding claim 3, Seth further disclose a range in thickness overlapping applicants' claimed limitation. While Seth fails to disclose an embodiment meeting applicants' claimed limitations, it would have been obvious to one having ordinary skill in the art to have determined the optimum value of a cause effective variable such as the thickness of the polypropylene backing layer through routine experimentation in the absence of a showing of criticality in the claimed thickness, especially given the teaching in Seth regarding the overlapping range in thickness. *In re Boesch*, 205 USPQ 215 (CCPA 1980), *In re Woodruff*, 16 USPQ2d 1934, 1936 (Fed. Cir. 1990).

Response to Arguments

6. The rejection of claims 2 and 3 under 35 U.S.C § 102 – Miyahara et al.

7. The rejection of claims 2 and 3 under 35 U.S.C § 102/103 – Seth

Applicant's arguments have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kevin M Bernatz whose telephone number is (703) 308-1737. The examiner can normally be reached on M-F, 9:00 AM - 6:00 PM.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Paul Thibodeau can be reached on (703) 308-2367. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9310 for regular communications and (703) 872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0651.



KMB
February 3, 2003



Paul Thibodeau
Supervisory Patent Examiner
Technology Center 1700